

Remarks:

Restriction Requirement under 35 U.S.C. § 121

The Applicant, after review of the Examiner's restriction requirement, hereby affirms election for further prosecution in the present application the invention of Group III, including claims 83–96, without traverse.

To clarify the prosecution history of the claims, claims 1–43 and 69–82 were cancelled in a preliminary amendment when this application was filed on 10/12/2000. Claims 44–68 were cancelled in a provisional election filed on 9/17/2002.

Applicant respectfully requests rejoinder of claims 97–110 to the elected invention. In accordance with the examiner's suggestions, Applicant has amended, without prejudice, independent claim 97 to include the limitations of the apparatus claim 83.

Drawing Objection

Applicant has removed the black dots from the figures and submits formal drawings with this reply. Applicant has not made any further changes to the figures in the formal drawings.

35 U.S.C. §112, first paragraph

The examiner has expressed 35 U.S.C. §112, first paragraph concerns with respect to claims 87 and 93. As best understood by Applicant, this rejection appears to be applicable to claims 87 and 94. As such, Applicant will respond as if claims 87 and 94 had been rejected.

The action suggests that the disclosure is not enabling purposing that three specified elements are "critical or essential" in the office's opinion. Although, the specification does explain the benefit of each of these various elements, it should be noted that nothing in the specification states that any of these are critical or essential. To the contrary, the specification is clear that various combinations are possible and can achieve the various desired advantages. In fact, even the questioned claims themselves (which 35 U.S.C. § 112 makes clear are part of the specification) show that the applicant disclosed -- and even intended to encompass -- the various combinations and not merely devices that encompassed all three of the specified elements. This is not only permissible under the law but is also properly enabled within the meaning of the statute.

Specifically, it should be noted that in the cited case, *In re Mayhew*, that specification explicitly showed that certain features were essential. This is very different from the present case which shows the exact opposite. Thus, it was the particular specification in the *Mayhew* case that governed the result. This can also be seen from the case of *Amgen*, where such a result was not found to apply in instances where the specification did not make a particular element necessary. *See Amgen v. Hoechst*, 314 F.3d 1313 (Fed. Cir. Mass).

Since a misunderstanding as to the true nature of the invention exists, it is explained that the suggested combination of elements should not be understood as being "critical or essential." Thus, it is respectfully explained that the elements are not required to be in the cited claims and that the situation of the *Mayhew* case does not exist in the present invention.

Rejection under 35 U.S.C. § 103(a):

Claims 83-86, 89, 91-92, and 94-96 were questioned under 35 U.S.C. §103(a) citing Hollinger et al. (U.S. Patent No. 4,515,274) (hereinafter referred to as '274). Applicant amends in part and respectfully traverses to overcome the rejection.

In the Office Action, it is acknowledged that, "Hollinger fails to teach that the parts are sealed or the claimed power source." Office Action of 10/03/2002 at pg. 5. Even if it may be obvious to seal, which Applicant does not admit, the Applicant has claimed, *inter alia*, a tip-to-body seal that is "*located off* of said inner surface." (emphasis added). Applicant respectfully notes that the rejection does not address the location of this seal, and this aspect is an important component to these particular claims.

The independent claim of this group, claim 83 recites a limitation, *inter alia*, of the tip-to-body seal being *located off* of said inner surface. This is not obvious from the '274 reference. As the action acknowledges, the '274 reference does not teach a seal. It also, of course, does not teach locating a tip-to-body seal off the inner surface. This, more subtle aspect is explicitly set forth in the claims and cannot be ignored. Naturally, mere existence of a device such as shown in Figure 1 of the '274 reference, would not likely make it certain or disclose the specific location of a tip-to-body seal. In this instance, this is even further compounded by the fact that the sealing location may be impacted by the particular parameters involved (such as pressure, viscosity, etc.). With appropriate parameters, the seal might even exist at the juncture on the inner surface between the body and the tip. Thus, it is respectfully submitted that a *prima facie* case of obviousness cannot be established with respect to claim 83 as originally recited.

It should be noted that the Applicant has amended claim 83, and corresponding method claim 97, to include, "so that said seal does not substantially adversely impact laminar flow within said nozzle volume..." This is done to clarify an aspect of the seal and to help the examiner understand a potential effect of the claimed arrangement. While Applicant has amended claims 83 and 97 for clarity, the scope of the claims have not been changed and the amendments merely cite the intended function of the seal.

Claims 84-86, 89, 91-92, 94-96 are ultimately made dependent on claim 83. While they pose other aspects which are patentable, these are not raised here. Since claim 83 is believed to be in condition for allowance as recited, claims 84-86, 89, 91-92, 94-96 are also believed to be in condition for allowance in that they each incorporate by reference all the limitations of the claims to which they are dependent. 37 C.F.R. 1.75(c). Should the office require further explanation, the Applicant stands ready to supplement the above remarks should it be necessary.

Conclusion

The applicant having addressed each of the office's concerns raised in the office action, respectfully requests reconsideration of the claims as amended and allowance of the claims as amended.

Dated this 3rd day of April, 2003.

Respectfully Submitted,
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